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PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Mark Weedmark, et al.
For : TRACING ACTIVE CONNECTION
MODIFY FAILURES
Serial No.: : 10/724,711
Filed : December 2, 2003
Art Unit : 2143
Examiner : Daniele C. Murray
Att. Docket : ALC 3101
Confirmation No. : 2221

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Sir:

REMARKS

Concurrent to the Notice of Appeal filed herewith, this Request is in response to the Final Office Action dated August 23, 2007.

REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects claims 1-8 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,643,267 to Karia et al. (hereinafter "Karia"). Appellant respectfully submits that this rejection is deficient for at least the following reasons.

Application No: 10/724,711
Attorney's Docket No: ALC 3101
Pre-Appeal Brief Request for Review

Although the caption of the rejection on page 2 indicates that it is only a rejection of claims 1-7, Appellant notes that, on page 4, the rejection includes claim 8. Further, Appellant notes that the Office Action Summary indicates that claim 8 is rejected. Thus, Appellant believes that the caption indicating that the rejection is a rejection of claims 1-7 is a vestige from the rejection that appeared in the December 27, 2006, non-final Office Action that was inadvertently copied into the pending final rejection.

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Excessive and Improper Reliance on "Inherency"

The rejection relies on an inherency argument three times in connection with claim 1. The rejection further relies on additional inherency arguments twice with respect to dependent

Application No: 10/724,711
Attorney's Docket No: ALC 3101
Pre-Appeal Brief Request for Review

claim 2. The Office Action further relies on an inherency argument with respect to dependent claim 3. The Office Action further relies on an inherency argument with respect to dependent claim 4. The Office Action further relies on an inherency argument with respect to dependent claim 6. The Office Action further relies on an inherency argument with respect to dependent claim 7. The Office Action further relies on two additional inherency arguments with respect to dependent claim 8. In all, the Office Action relies on eleven inherency arguments with respect to the rejection of pending claims 1-8.

Appellant notes that the rejection of claims 1-7 is repeated verbatim from the rejection of those claims that appeared in the December 27, 2006, non-final Office Action. In response thereto, Appellant pointed out that the rejection correctly concedes that Karia fails to disclose, teach or suggest a large portion of the subject matter recited in the rejected claims. In fact, Appellant respectfully asserts that the rejection correctly concedes that Karia fails to disclose, teach or suggest significantly more than half of the subject matter recited in the rejected claims! On this basis alone, Appellant respectfully asserts that the Office Action has excessively and improperly relied on allegations of inherency in putting forth the rejection. Appellant respectfully asserts that the rejection should be reversed on this basis alone.

In support of the foregoing position, by way of example, and by way of example only, Appellant's previous response focused on the recitation in claim 1 of "modifying a parameter." In sections 4 and 5 on pages 5 and 6, the Office Action includes a Response to Arguments section. However, the Response to Arguments section entirely ignores Appellant's argument that the reliance on inherency in the rejection is excessive and improper.

Application No: 10/724,711
Attorney's Docket No: ALC 3101
Pre-Appeal Brief Request for Review

Improper Reliance On Secondary References

In the Response to Arguments section, both in section 4 on page 5 and extensively in section 5 on page 6, the Response to Arguments relies on documents made of record by Appellant. Appellant respectfully submits that the rejection's reliance on these many documents in connection with the rejection, without applying the documents as documents relied upon as the basis for the rejection, is improper.

Appellant respectfully submits that, in order to be properly crafted, the rejection should be listed as a rejection(s) under 35 U.S.C. §103(a) based on combinations of Karia and the additional documents relied upon in the Response to Arguments sections 4 and 5 on pages 5 and 6. Appellant respectfully submits that, even assuming *arguendo* that the Office Action's reliance on the many documents is proper, which it is not, at a minimum the rejection is reversible due to its failure to apply all the documents relied upon for the rejection.

Appellant respectfully requests that the rejection be reversed on this basis as well.

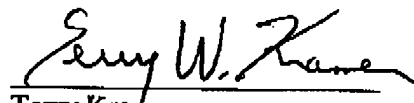
Application No: 10/724,711
Attorney's Docket No: ALC 3101
Pre-Appeal Brief Request for Review

CONCLUSION

While we believe that the instant pre-appeal brief places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.


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Date: December 26, 2007

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